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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/169,839	10/09/1998	DEBBY HINDUS	INT1P019	6129

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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 06/04/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/169,839

Applicant(s)

HINDUS ET AL.

Examiner

Edwin C. Holloway, III

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

EXAMINER'S RESPONSE

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3-12-03 has been entered.
2. In response to applicant's amendment filed 3-12-03, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out the support in the specification as originally for the limitations "wherein said indication comprises a message programmed into the receiving device by a

Art Unit: 2635

programming individual other said second individual" in claims 1 and 27, the limitation of "wherein the programming individual is the first individual" in claims 43 and 46, nor the limitation of "wherein the message is programmed into the receiving device prior to the presence signal is sent from the transmitting device" in claims 44 and 47. Page 12 line 5 - page 13 line 9 discloses an embodiment with notes that are audio messages a significant other has pre-recorded onto the device and can then remotely unveil by causing the message to be played, but this embodiment lacks physical locations and physical data line of claims 1 and 27.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-2, 4-6, 7-10, 22, 25, 27-28, 30-33, 43-44 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) in combination with Ise (US 5257307).

Richardson discloses a two way paging system with a presence signal. In view of page 8 of applicant's specification, the call back number and/or additional message in col. 4 lines 21-22 or "call me at home" in col. 10 lines 34-36 of Richardson, or any paging message corresponds to a presence signal. The transmitting device may be provided by a telephone 125/135 or computer 145 connected to a telephone line 141/142/149 in fig. 2 and col. 3 lines 22-45 where a first user or caller enters a message. It is considered inherent or obvious in the conventional telephone system that these transmitting devices are at the same location as the telephone line they are

Art Unit: 2635

connected. The virtual pagers 242 function as receiving devices at a second location. The second location may change, but this is not precluded by the claims. The receiver includes programmed messages such as catch words in cols. 4 and 9-11, but they are programmed by the user of the receiver. Alternatively, col. 11 line 54 - col. 12 line 13 disclose pre-recorded messages entered or programmed by a subscriber functioning as a first user to be presented to an originator functioning as a second user, but this interpretation would lack first location with physical line.

Ise discloses an analogous art paging system and method where canned messages are stored on memory cards of two transceivers. Canned messages programmed onto one card are copied to second card so that messages programmed by a first user are stored in the memory of the second device. See col. 7 lines 37-44. This provides advantages such as permitting secret communication, reducing the amount of data transmitted and the number of key operations. Ise also discloses a pager coupling to a telephone line to send a message in fig. 5 and col. 8 line 41 - col. 10 line 52 to avoid the labor and errors compared to user operating a telephone directly.

^{Ise}
Wright discloses an analogous art paging system and method where canned messages are stored on memory cards of two transceivers.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have to have included in Richardson the first user programming the message into the receiver then in view of the copying of the memory card of Ise for advantages such as permitting secret communication, reducing the amount of data transmitted and the number of key operations. Additionally, it would have been obvious

Art Unit: 2635

to have used a pager as a first or acknowledgment transmitting device with coupling to the base station provided by a telephone line at the location of the pager as disclosed Ise to avoid the labor and errors compared to user operating a telephone directly and suggested by the transmitting pre-recorded messages from the pager to the originator in Richardson. Regarding claim 25, since the transmitter and receiver of Ise have memory cars with paired messages, they are matches pairs.

7. Claims 19-21, 23-24 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) and Ise (US 5257307) as applied above and further in view of Will (US 5479408).

Will discloses a two way paging system as claimed. In view of page 8 of applicant's specification, the acknowledgments, responses, original messages, location tracking, or any paging message corresponds to a presence signal. This allows highly reliable message delivery. See the abstract. Preprogrammed messages and responses can be defined by a user to be presented to another user as an original message or a response. A picture frame is included in figs. 6a-c, 8a-c and cols. 11-12. for quick and easy instillation. Col. 3 includes messages selecting from preprogrammed or composed by the user corresponding to modifying messages. See for example, Col. 5 lines 14-31, col. 16 lines 48-61, col. 19 lines 35-53, col. 16 line 20 - col. 28 line 36 and col. 36 line 61 - col. 37 line 35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the frame of claims 19-21 and 38-41 in view of the frame of Will in an analogous art system for quick

Art Unit: 2635

and easy instillation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the message modification in view of the message composing in Will for highly reliable message delivery.

Will discloses transceiver in figs. 4A-4C which is considered to be a picture frame because it holds a photo ID 46. This frame includes a touch sensitive switch or key 48. A relay station is shown in figs. 6A-6C and 8A-8B to include a picture frame discussed on pages 11-12, and if it is not clear that the transceiver is a with key 48 is a frame then it would have been an obvious various in location of parts or obvious integration of parts to have combined transceiver with key 48 and the picture frame for user input. It further would have been obvious to have included this frame in the system of Richardson in order to identify the user or to blend into the environment.

8. Claims 3, 23-24, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) and Ise (US 5257307) as applied above and further in view of LaPorta (US 5959543) .

LaPorta discloses an analogous art two way paging system with group call message modification (abstract, col. 14) and it would have obvious to have included such in the combination applied above to provide a more advanced set of transaction services.

9. Claims 11, 14-16, 18, 34-37, 42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) and Ise (US 5257307) as applied above and further in view of Segal (US 5644627) and Poland (US 5401947).

Segal discloses an analogous art two way paging system with indication by audible or voice message, visual LED or LCD, or tactile signal (cols. 4-5). Tactile is vibratory or haptic motion. Poland discloses an analogous art selective indicator with heated (thermochromic) liquid crystal ink markings printed on a display. It would have been obvious to have included such indicators in the combination applied above to provide the user the convenience and flexibility of selecting from the various indicator modes and the heated LCD is suggested by Richardson indicating use of any well known visual display such as LCD in col. 7 and will showing LCD in col. 4A.

10. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458), Ise (US 5257307), Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of Easterling (US 5651049).

Easterling discloses an analogous art paging system with a receivers embedded in objects such as stuffed animals and it would have been obvious to have included such in the combination applied above in order to relate the receiver to the corresponding user or message recipient.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) and Ise (US 5257307) in view of Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of McLaughlin (US 4975694).

McLaughlin discloses an analogous art paging receiver with a multiple color LED or lamp indicator and it would have been obvious to have included such in the combination applied above in order to provide multiple indications with a single lamp.

Art Unit: 2635

12. Claims 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458), Ise (US 5257307), Segal (US 5644627) and Poland (US 5401947) as applied above and further in view of Park (US 5733131).

Park discloses an analogous art paging receiver with a mechanical control such as movement of the mouth of a stuffed animal (fig. 2) and telephone input to the paging system (fig. 1). It would have been obvious to have included such in the combination applied above in order to provide inexpensive educational and/or entertainment device.

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (US 5459458) and Ise (US 5257307) as applied above in view of Shapira (US 5086394).

Shapira discloses an analogous art paging system with matched pairs and if matched pairs are not clear in Ise, then it would have been obvious to have included such match pairs in the combination applied above in order to provide introduction of users.

Response to Arguments

14. Applicant's arguments filed 3-12-03 have been fully considered but they are not persuasive and/or are moot in view of new grounds of rejection. Applicant's argument that the prior art lacks message physical location and physical data line is not persuasive in view of the telephone lines 141-149 of Richardson and/or the telephone line of Ise. Further, the amendments necessitated rejection under 35 USC 112 first paragraph for new matter.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wright (US 5839054) discloses a paging base station with a button dedicated to a pager.


CONTACT INFORMATION

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2600 receptionist whose telephone number is **(703) 305-4700**.

Facsimile submissions may be sent via fax number (703) 872-9314 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30:-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH
5/30/03


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635